Remarks

This paper responds to the first Office action in the above-entitled application, mailed August 24, 2005, and allowing three months for a response. This response is timely because it is being filed within the period set for response.

The applicant will address all the points raised by the Examiner and demonstrate that the present claims 1-64 are patentable for the reasons provided below. Reexamination of the application is therefore respectfully requested.

35 U.S.C. § 102 (Novelty)

The applicant has been asked to show that claims 1-2, 5-8, and 11-49 in this case are novel compared to the Segal et al. reference (US 2001/0041991). The applicant respectfully submits that these claims are novel because the present claims and the Segal reference differ.

Claim 1 is distinguished from the Segal reference at least because that claim recites "inducing said patient to obtain possession of a medical record of said patient from a covered entity," which the Segal reference does not teach. Similarly, claims 2-64, which contain similar limitations, are distinguished from the Segal reference.

The Office action cites Paragraphs [0014] and [0151] of Segal, which respectively state:

> [0014] In an attempt to provide patients with greater control over their medical records, several PMR services provide Internet websites in which to store, update, and retrieve patient medical records. Some of the websites provide medical data management as a primary function while others provide the service as a part of a larger health website. Examples of these websites include epicsys.com™, abaton.com™, medscape.com™, medicalrecord.com™, medbroadcast.com™, TheHealthNetwork.com™, 4healthylife.com™, healthmagic.com™, personal-md.com™, wellmed.com™, webmd.com™, aboutmyhealth.net™, and vista-link.com™. While some websites, such as epicsys.com™ and abaton.com™, provide PMR services for health groups (e.g., health administrators, clinicians, and hospitals), the remaining websites, as well as the present invention, target the consumer, or patient, and give the patient ownership and control of the medical records.
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> * * *

> [0151] Related to the privacy concerns addressed by Super PERC, an alternate embodiment of the present invention provides the software applications of the present invention on a compact disk or other portable storage medium, instead of through the Internet. In this manner, a patient leery of posting information on the web can simply load the applications on her personal computer and save the medical record information to her computer's hard drive. The patient would then bring the medical record to the service provider on a portable storage medium, e.g., a floppy disk, so that the service provider could download the information onto a PERC or Super PERC. Alternately, the patient could obtain the hardware necessary to perform the downloading. Physicians would also have copies of the software applications so that the patient could bring her medical record to the physician's office and update it with the physician without using the web-based applications and data storage. As necessary, the service provider would provide updates to the patients and physicians for the non-web based software applications.

The above-quoted paragraphs do not disclose "inducing said patient to obtain possession of a medical record of said patient from a covered entity." (Examples of a "covered entity" are a medical office or hospital where the patient has been treated, which maintain records of that treatment.)

- Starting with "inducing," the above-quoted paragraphs of Segal do not disclose that the patient was induced (i.e. caused by someone else) to obtain the records from the covered entity. Consistent with the above-quoted paragraphs of Segal, the patient could have obtained the medical records from the covered entity on his or her own initiative, without inducement by anyone. Also consistent with the above-quoted paragraphs of Segal, the covered entity could have given the preexisting records to the patient, without any effort by the patient to obtain possession of the records.
- The quoted paragraphs of Segal do not indicate the records are obtained from a covered entity (they could, for example, be the patient's self-written summary of his or her medical treatment).
- The "service provider" referenced in the latter paragraph of Segal is not providing a medical record to the patient; the service provider is receiving a medical record the patient already possesses.

The Office action states on page 3, part (a), "Segal teaches that the patient has ownership and control of their medical records. As such, other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their medical records for them." But Segal, quoting the last lines of paragraph [0014], does not disclose anyone inducing the patient to acquire a medical record from a covered entity. Segal, paragraph [0014], only states, "the remaining websites, as well as the present invention, target the consumer, or patient, and give the patient ownership and control of the medical records." Segal does not disclose that "other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their [the patient's] medical records for them [other parties]." Rather, Segal indicates that "other parties interested in acquiring a medical record from a patient" would simply need to induce the patient, who already owns and controls his or her own records, to send the records to the "other parties."

Additionally the term "induce" introduces a time element. The claim recites inducing the patient to obtain possession of a record. "Inducing" is the cause, and "obtain[ing]" is the effect. If the patient already possesses the record, one can no longer induce the patient to obtain possession of the record. This is so because, logically, a cause must precede its effect. For example, you can't induce a student to fail a test by preventing him from studying the day after he took and turned in the test. You would have had to prevent him from studying before he took the test. Preventing him from studying is the cause or inducement, and failing the test is the effect. The two cannot logically be reversed.

Claims 1-49, as well as new claims 50-64, are therefore novel.

35 U.S.C. § 103 (Non-obviousness)

The applicant has been asked to show that certain claims in this case are non-obvious in view of the Segal reference in combination with the Mok et al. or Judson et al. reference. The applicant respectfully submits that these claims are non-obvious, as the claims are all novel in view of the Segal reference, and the combinations of references proposed to meet the present claims are not obvious.

As shown above, all the present claims are distinguished from the Segal reference at least because they all recite, in the same or similar terms, "inducing said patient to obtain possession of a medical record of said patient from a covered entity," which the Segal et al. reference as applied by the Examiner does not teach.

Mok, as shown in Fig. 3, shows direct transfer of medical records from covered entities (physicians) to a "Central data repository" 210, but the repository 210 is itself a "health care clearinghouse" (HCC). Repository 210 of Mok is an HCC because Mok discloses that the operator of the repository 210 performs data processing by translation or conversion of medical records to or from a standard data format. In some cases, this is done at the direction of a physician representing a covered entity. Compare paragraphs [0034]-[0035] of the present specification, describing a health care clearinghouse, to the following paragraphs of Mok:

- [0074], [0021] (the Mok system forms a database of the records, which is data processing);
- [0024]-[0025] (the Mok system produces a timeline report, which is data processing);
- [0026] (in the Mok system a physician is able to direct data processing on the repository 210);
- [0080] (in the Mok system a physician is able to modify to records kept on the system by adding comments);
- [0083], lines 13-15: "Thus all documents of a patient's medical history are categorized with at least one medical sub-category given in Fig. 15." This is data processing in the Mok system.
- [0084] (the Mok system uses the system-created data base for sorting, searching, and report generation, which are data processing by the operator of the repository 210).

Mok thus fails to show "inducing said patient to convert said medical record into a storage format," as recited in claim 1 and thus required by the rejected claims. The Mok record management system performs this function itself, and thus engages in data processing of a

medical record. Judson also fails to show either inducing step required by claim 1, an antecedent to the rejected claims.

The present invention is not obvious in view of any combination of the applied references, absent hindsight. The references do not mention or suggest HIPAA requirements, much less teach a way to obtain records free of such requirements. The references therefore lack any motivation to obtain medical records free of HIPAA requirements, by inducing the patient to get and process the records him- or herself. For that reason and others, the claimed invention is not obvious in view of the applied prior art.

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

§ 2142 MANUAL OF PATENT EXAMINING PROCEDURE, 8th ed., Rev. 3 (Aug. 2005), Ch. 2100, p.134.

Therefore, this rejection should be withdrawn.

35 U.S.C. § 132 (Amendments Supported)

New claims 50 and 55 reciting "said medical record is made by the covered entity before said inducing" are supported in Paragraph [0045] of the specification.

New claim 51 reciting "said inducing occurs before the patient obtains possession of the medical record" is supported in Paragraph [0043] of the specification.

New claim 52 reciting "the patient obtains possession of the medical record before said acquiring" is supported in Paragraphs [0045]-[0047] of the specification.

New claims 53 and 58 reciting "the patient has a computer with Internet access, and said inducing further comprises inducing said patient to obtain possession in said patient's computer

of said medical record in digital form from a covered entity" are supported in Paragraphs [0040] and [0045]-[0046] of the specification.

New claims 54 and 59 reciting "inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity" are supported in Paragraph [0050] of the specification.

New claim 56 reciting "inducing the patient to obtain possession of a medical record occurs before the patient obtains possession of the medical record" is supported in Paragraph [0043] of the specification.

New claim 57 reciting "the patient obtains possession of the medical record before the patient stores the medical record" is supported in Paragraph [0045] of the specification.

New claim 60 reciting "the communication interface is adapted for inducing said patient to obtain possession of a medical record after said medical record is made by the covered entity" is supported in Paragraphs [0045]-[0046] of the specification.

New claim 61 reciting "the communication interface is adapted for inducing said patient to obtain possession of a medical record before the patient obtains possession of the medical record" is supported in Paragraph [0045] of the specification.

New claim 62 reciting "the communication interface is adapted for obtaining possession of a medical record by the patient before the data storage device stores said medical record" is supported in Paragraph [0045]-[0047] of the specification.

New claim 63 reciting "the communication interface is adapted for inducing said patient to obtain possession, in a computer possessed by said patient, of said medical record in digital form from a covered entity" is supported in Paragraph [0059] of the specification.

New claim 64 reciting "the communication interface is adapted for inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity" is supported in Paragraph [0050] of the specification.

The other claims are original claims, thus supported by the specification as originally filed.

The claims in this paper are therefore free of new matter.

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Conclusion

The applicant has shown that this application satisfies all the legal requirements pointed out by the Examiner. Therefore, the Examiner is respectfully requested to prepare a Notice of Allowability allowing all the pending claims (1-64).

Respectfully submitted,

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